

ESTTA Tracking number: **ESTTA759414**

Filing date: **07/20/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Shoe Show, Inc.		
Entity	Corporation	Citizenship	North Carolina
Address	2201 Trinity Church Road Concord, NC 28027 UNITED STATES		
Attorney information	Kathleen Gallagher-Duff Covington & Burling LLP One CityCenter, 850 Tenth Street NW Washington, DC 20001 UNITED STATES trademarks@cov.com Phone:202.662.5299		

### Registration Subject to Cancellation

Registration No	4712944	Registration date	03/31/2015
Registrant	Gilt Groupe, Inc. 2 Park Avenue, 5th Floor New York, NY 10016 UNITED STATES		

### Goods/Services Subject to Cancellation


Class 025. First Use: 2013/04/04 First Use In Commerce: 2013/04/04  
All goods and services in the class are cancelled, namely: Clothing, namely, dresses, tops, pants, shorts, shirts, jackets, rompers, jumpers, and outerwear in the nature of jackets and coats

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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### Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86567027	Application Date	03/17/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MARBELLA		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 Footwear

U.S. Registration No.	2116452	Application Date	02/19/1997
Registration Date	11/25/1997	Foreign Priority Date	NONE
Word Mark	MARBELLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1995/07/17 First Use In Commerce: 1995/07/17 handbags		

Attachments	86567027#TMSN.png( bytes ) MARABELLE Petition for Cancellation.pdf(565682 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/KathleenGallagher-Duff/
Name	Kathleen Gallagher-Duff
Date	07/20/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 4,712,944 – MARABELLE  
Registered: March 31, 2015

SHOE SHOW, INC.,

Petitioner,

v.

GILT GROUPE, INC.,

Respondent.

Cancellation No. \_\_\_\_\_

**PETITION FOR CANCELLATION**

Shoe Show, Inc. (“Petitioner”), a North Carolina corporation located and doing business at 2201 Trinity Church Road, Concord, North Carolina 28027, believes that it is, and will be, damaged by Reg. No. 4,712,944, and hereby petitions to cancel the same pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. § 1064 *et seq.*, as amended. Reg. No. 4,712,944 is a registration on the Principal Register for the mark MARABELLE. The registration issued on March 31, 2015 to Gilt Groupe, Inc. (“Respondent”), with a last known business address at 2 Park Avenue, 5th Floor, New York, New York 10016. The registration covers “clothing, namely, dresses, tops, pants, shorts, shirts, jackets, rompers, jumpers, and outerwear in the nature of jackets and coats,” in International Class 25.

As grounds for cancellation, Petitioner alleges that:

1. On March 17, 2015, Petitioner filed with the U.S. Patent and Trademark Office (“PTO”) a registration application for the mark MARBELLA for footwear (Serial No. 86/567,027). On June 25, 2015, the PTO Examining Attorney assigned to review Petitioner’s MARBELLA application for footwear refused registration of the mark on the ground that it is confusingly similar to Respondent’s Reg. No. 4,712,944 for the mark MARABELLE for clothing, namely, dresses, tops, pants, shorts, shirts, jackets, rompers, jumpers, and outerwear in the nature of jackets and coats.

2. The Examining Attorney determined that the marks MARBELLA and MARABELLE sound similar to each other because both marks feature the sound “MAR” as the first syllable and the sound “BELL;” consumers generally are more inclined to focus on the first word, prefix, or syllable in any trademark or service mark; and the goods identified by Respondent’s registration (apparel) and Petitioner’s application (footwear) are closely related.

3. The Examining Attorney concluded that “when consumers encounter applicant’s [Shoe Show’s MARBELLA] mark and registrant’s [Gilt Groupe’s MARABELLE] mark for the closely-related goods, they are likely to be confused and believe that the parties’ goods all emanate from the same source.

4. Petitioner has adopted and has used in interstate commerce, from a time prior to any date upon which Respondent can rely, its mark MARBELLA to identify handbags and footwear.

5. Petitioner is the owner of a federal registration on the Principal Register of the PTO for MARBELLA for handbags (Reg. No. 2,116,452). The registration is valid and subsisting and incontestable. Therefore, it is prima facie evidence of Petitioner’s exclusive right to use its MARBELLA mark in commerce on the goods specified in the registration. Attached

hereto as Exhibit A are a copy of the registration certificate for, and a printout of the status of, Reg. No. 2,116,452 from the PTO's Trademark Status and Document Retrieval ("TSDR") database.

6. Petitioner has used its MARBELLA mark on handbags since at least as early as July 17, 1995 and on footwear since at least 1997. As a result of regular use for 21 years on handbags and 19 years on footwear, Petitioner's MARBELLA mark has become known to the public as a mark associated with Petitioner, and Petitioner has acquired significant goodwill associated therewith.

7. By adopting and using its MARBELLA mark for an extensive period of time, Petitioner has acquired exclusive rights in such mark, which rights are superior to those of Respondent in the mark MARABELLE.

8. Respondent's mark MARABELLE is confusingly similar to Petitioner's MARBELLA mark. Both marks consist of three syllables, and as the PTO Examining Attorney acknowledged, both marks begin with the same syllable "Mar" and include the sound "Bell." The commercial impressions of Petitioner's MARBELLA mark and Respondent's MARABELLE mark are confusingly similar.

9. The goods identified by Respondent's MARABELLE registration -- clothing, namely, dresses, tops, pants, shorts, shirts, jackets, rompers, jumpers, and outerwear in the nature of jackets and coats -- are closely related to the goods covered by Petitioner's MARBELLA mark, namely, footwear and handbags.

10. On information and belief, Respondent's goods travel in the same channels of trade and are sold to the same class of consumers as goods identified by Petitioner's MARBELLA mark.

11. The adoption and use by Respondent of the mark MARABELLE for various apparel is likely to cause confusion with Petitioner's use of its MARBELLA mark, and is likely to cause consumers to assume, erroneously, that Respondent's goods originated with, or are approved by or somehow are associated with, Petitioner. Petitioner's invaluable goodwill in its MARBELLA mark will be seriously jeopardized thereby.

12. Petitioner will be damaged by continuance of Registration No. 4,712,944 for the mark MARABELLE for various apparel because such registration was cited by the PTO Examining Attorney assigned to review Petitioner's MARBELLA application for footwear (Serial No. 86/567,027) as a bar to registration of said application of Petitioner. The continued registration of Respondent's mark MARABELLE (Reg. No. 4,712,944) thus blocks federal registration of Petitioner's mark MARBELLA for footwear, will assist and support Respondent in the confusing and misleading use of the mark MARABELLE, and will continue to provide rights to Respondent in violation and derogation of the prior and superior rights of Petitioner.

13. To the best of Petitioner's knowledge, the name and address of the registrant of Reg. No. 4,712,944 are Gilt Groupe, Inc. at 2 Park Avenue, 5th Floor, New York, New York 10016.

14. For the reasons set forth in paragraphs one through twelve herein, Petitioner asserts that it is and will be damaged by the continued subsistence of Reg. No. 4,712,944 and, therefore, files this cancellation petition.

WHEREFORE, Petitioner requests that this cancellation petition be sustained and that Reg. No. 4,712,944 for the mark MARABELLE be cancelled.

Respectfully submitted,

SHOW SHOE, INC.

By:



BINGHAM B. LEVERICH

KATHLEEN T. GALLAGHER-DUFF

MARIE A. LAVALLEYE

COVINGTON & BURLING LLP

One CityCenter

850 Tenth Street, N.W.

Washington, D.C. 20001

Tel: 202-662-6000

Fax: 202-662-6291

Counsel for Petitioner

SHOW SHOE, INC.

Dated:



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In re Registration No. 4,712,944 – MARABELLE  
Registered: March 31, 2015

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Respondent.

Cancellation No. \_\_\_\_\_

**CERTIFICATE OF SERVICE**

This is to certify that I have this 20th day of July, 2016, served Respondent with the foregoing Petition for Cancellation by email (trademarks@gilt.com) and by depositing a copy of the same in the United States mail, postage prepaid and properly addressed as follows:

Jennifer Sloan, Esq.  
Gilt Groupe, Inc.  
2 Park Avenue  
5th Floor  
New York, New York 10016

  
Kathleen T. Gallagher-Duff  
Counsel for Petitioner Shoe Show, Inc.



# **EXHIBIT A**

**Int. Cl.: 18**

**Prior U.S. Cls.: 1, 2, 3, 22 and 41**

**Reg. No. 2,116,452**

**United States Patent and Trademark Office**

**Registered Nov. 25, 1997**

**TRADEMARK  
PRINCIPAL REGISTER**

**MARBELLA**

SHOE SHOW, INC. (NORTH CAROLINA CORPORATION)  
776 FLORENCE STREET, N.W., P. O. BOX 648  
CONCORD, NC 280260648

FIRST USE 7-17-1995; IN COMMERCE  
7-17-1995.



SER. NO. 75-244,130, FILED 2-19-1997.

FOR: HANDBAGS, IN CLASS 18 (U.S. CLS. 1,  
2, 3, 22 AND 41).

LAVERNE THOMPSON, EXAMINING ATTORNEY

1. The Post Registration "Maintenance Tab" has been temporarily disabled. It will return soon.

2. TSDR now displays information regarding [TM5 Common Status Descriptors](#).

STATUS		DOCUMENTS		<a href="#">Back to Search</a>		 Print	
Generated on:		This page was generated by TSDR on 2016-07-20 11:41:51 EDT					
Mark:		MARBELLA				No Image exists for this case.	
US Serial Number:		75244130		Application Filing Date:		Feb. 19, 1997	
US Registration Number:		2116452		Registration Date:		Nov. 25, 1997	
Register:		Principal					
Mark Type:		Trademark					
TM5 Common Status Descriptor:				LIVE/REGISTRATION/Issued and Active The trademark application has been registered with the Office.			
Status:		The registration has been renewed.					
Status Date:		Nov. 20, 2007					
Publication Date:		Sep. 02, 1997					
▼ Mark Information <span>▲ Collapse All</span>							
Mark Literal Elements:		MARBELLA					
Standard Character Claim:		No					
Mark Drawing Type:		1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)					
▼ Goods and Services							
Note: The following symbols indicate that the registrant/owner has amended the goods/services: <ul style="list-style-type: none"><li>• Brackets [...] indicate deleted goods/services;</li><li>• Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and</li><li>• Asterisks *..* identify additional (new) wording in the goods/services.</li></ul>							
For:		handbags					
International Class(es):		018 - Primary Class		U.S Class(es):		001, 002, 003, 022, 041	
Class Status:		ACTIVE					
Basis:		1(a)					
First Use:		Jul. 17, 1995		Use in Commerce:		Jul. 17, 1995	
▼ Basis Information (Case Level)							

<b>Filed Use:</b>	Yes	<b>Currently Use:</b>	Yes	<b>Amended Use:</b>	No
<b>Filed ITU:</b>	No	<b>Currently ITU:</b>	No	<b>Amended ITU:</b>	No
<b>Filed 44D:</b>	No	<b>Currently 44D:</b>	No	<b>Amended 44D:</b>	No
<b>Filed 44E:</b>	No	<b>Currently 44E:</b>	No	<b>Amended 44E:</b>	No
<b>Filed 66A:</b>	No	<b>Currently 66A:</b>	No		
<b>Filed No Basis:</b>	No	<b>Currently No Basis:</b>	No		

Current Owner(s) Information

<b>Owner Name:</b>	SHOE SHOW, INC.		
<b>Owner Address:</b>	2201 TRINITY CHURCH ROAD CONCORD, NORTH CAROLINA UNITED STATES 28027		
<b>Legal Entity Type:</b>	CORPORATION	<b>State or Country Where Organized:</b>	NORTH CAROLINA

Attorney/Correspondence Information

Attorney of Record

<b>Attorney Name:</b>	Kathleen T. Gallagher-Duff, Esq.	<b>Docket Number:</b>	029137.00101
<b>Attorney Primary Email Address:</b>	<a href="mailto:trademarks@cov.com">trademarks@cov.com</a>	<b>Attorney Email Authorized:</b>	Yes

Correspondent

<b>Correspondent Name/Address:</b>	Kathleen T. Gallagher-Duff, Esq. Covington & Burling LLP One CityCenter, 850 Tenth Street, N.W. Washington, DISTRICT OF COLUMBIA UNITED STATES 20001		
<b>Phone:</b>	202-662-5299	<b>Fax:</b>	202-778-5299
<b>Correspondent e-mail:</b>	<a href="mailto:trademarks@cov.com">trademarks@cov.com</a>	<b>Correspondent e-mail Authorized:</b>	Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 10, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Feb. 25, 2011	ATTORNEY REVOKED AND/OR APPOINTED	
Feb. 25, 2011	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Nov. 20, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	68973
Nov. 20, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Nov. 16, 2007	ASSIGNED TO PARALEGAL	68973
Nov. 14, 2007	TEAS SECTION 8 & 9 RECEIVED	
Aug. 22, 2007	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	

Feb. 08, 2007	CASE FILE IN TIGRS	
Sep. 16, 2004	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Feb. 10, 2004	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Nov. 25, 2003	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Nov. 25, 2003	TEAS SECTION 8 & 15 RECEIVED	
Nov. 25, 1997	REGISTERED-PRINCIPAL REGISTER	
Sep. 02, 1997	PUBLISHED FOR OPPOSITION	
Aug. 01, 1997	NOTICE OF PUBLICATION	
Jul. 03, 1997	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 18, 1997	ASSIGNED TO EXAMINER	69809
▼ Maintenance Filings or Post Registration Information		
Affidavit of Continued Use:  Affidavit of Incontestability:  Renewal Date:	Section 8 - Accepted	
	Section 15 - Accepted	
	Nov. 25, 2007	
▼ TM Staff and Location Information		
TM Staff Information - None		
File Location		
Current Location:	POST REGISTRATION	Date in Location: Nov. 20, 2007
▼ Assignment Abstract Of Title Information - Click to Load		
▼ Proceedings - Click to Load		